



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/823,787 | 03/30/2001 | Maureen McMahon | ROXIP204 | 7422 |

25920 7590 09/07/2006

MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

EXAMINER

SELLERS, DANIEL R

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2615

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 09/823,787 | Applicant(s) MCMAHON ET AL. | |
| | Examiner Daniel R. Sellers | Art Unit 2615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-15 and 17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. **Claims 1-5, 7-15, and 17-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hollingworth, Kurpiers, and Abecassis, USPN 6,192,340.

4. Regarding **claim 1**, Hollingworth teaches a method for recording MP3 files to optical media (p. 1, para. 1-2), wherein a project to record audio files is initiated, browsing the MP3 files at a source location, selecting MP3 files, causing an automatic construction of a playlist of MP3 files to be executed at the destination optical media (p. 3, para. 1, #2-8). Hollingworth does not teach filtering to identify only MP3 files,

Art Unit: 2615

however Hollingworth teaches the use of WinAmp V2.5e (p. 2, para. 6, #3), which allows the user to initiate project filtering through a browse files dialog. It is *admitted prior art* that WinAmp can filter MP3 files in the browse dialog. Hollingworth does not teach recording the playlist to the destination optical media. Kurpiers teaches a method of recording MP3 files and a playlist to an optical disc (p. 42, Playlists and Programmes). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Hollingworth and Kurpiers for the purpose of keeping track of the large amount of media files that can be contained on the CD. It is obvious to one of ordinary skill in the art of the invention that a plurality of playlists can index the audio MP3 files in many different categories according to the construction of the playlists.

The combination of Hollingworth and Kurpiers fails to teach or suggest that the automatic constructing of the playlist does not require user interaction regarding creation of the playlist. Abecassis teaches automatic playlist creation using a user's music preferences (Col. 15, lines 45-57). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Hollingworth, Kurpiers, and Abecassis for the purpose of compiling a playlist of favorite selections quickly.

5. Regarding **claim 2**, the further limitation of claim 1, Hollingworth teaches selecting a MP3 project of a media recording application (p. 1, para 2).

Art Unit: 2615

6. Regarding **claim 3**, the further limitation of claim 2, Hollingworth teaches configuring the media recording application for a data recording session (p. 2, "How Does It Work?", para. 2-5).
7. Regarding **claim 4**, the further limitation of claim 3, Kurpiers teaches a CD player OSCAR. OSCAR supports a Joliet format (see the included reference OSCAR User Manual Version A4, p. 3, bullet 7).
8. Regarding **claim 5**, the further limitation of claim 2, Hollingworth teaches the use of WinAmp, wherein WinAmp uses a graphical user interface (GUI) to display MP3 files for browsing and selecting. It is *admitted prior art* that WinAmp provides this GUI.
9. Regarding **claim 7**, the further limitation of claim 1, the combination teaches editing the playlist prior to recording the selected MP3 files and playlist to the optical media.
10. Regarding **claim 8**, the further limitation of claim 7, the combination teaches a GUI for editing the playlist. This feature is provided through WinAmp.
11. Regarding **claim 9**, the further limitation of claim 7, the OSCAR User Manual teaches that the playlist file, i.e. the m3u file, is comprised of just a list of file paths and file names pointing to the files for playback on the destination media (p. 16, "Playlists on CD ROM or hard disk (.M3U-Files)").
12. Regarding **claim 10**, see the preceding argument with respect to claim 1. The combination of Hollingworth, Kurpiers, and Abecassis teaches computer media with these features.

Art Unit: 2615

13. Regarding **claim 11**, the further limitation of claim 10, see the preceding argument with respect to claim 2. The combination teaches these features.
14. Regarding **claim 12**, the further limitation of claim 10, see the preceding argument with respect to claim 3. The combination teaches these features.
15. Regarding **claim 13**, the further limitation of claim 12, see the preceding argument with respect to claim 4. The combination teaches these features.
16. Regarding **claim 14**, the further limitation of claim 10, see the preceding argument with respect to claim 9. The combination teaches these features.
17. Regarding **claim 15**, see the preceding argument with respect to claim 1. The combination teaches these features.
18. Regarding **claim 17**, the further limitation of claim 15, see the preceding argument with respect to claim 9. The combination teaches these features.
19. Regarding **claim 18**, the further limitation of claim 15, see the preceding argument with respect to claim 5. The combination teaches these features.
20. Regarding **claim 19**, the further limitation of claim 15, the combination teaches the use of WinAmp, wherein it is *admitted prior art* that WinAmp provides a GUI that displays the MP3 files in at least one source location and a separate display of the selected particular ones of the MP3 files.
21. Regarding **claim 20**, the further limitation of claim 15, the combination teaches M3U playlist files, wherein the building data structure includes keeping a list in memory of the selected particular ones of the MP3 files in an order in which they were selected.

Art Unit: 2615

22. Regarding **claim 21**, see the preceding argument with respect to claim 1. The combination teaches these features.

23. Regarding **claim 22**, the further limitation of claim 21, see the preceding argument with respect to claim 2. The combination teaches these features.

24. Regarding **claim 23**, the further limitation of claim 21, the combination teaches a GUI, see the preceding argument with respect to claims 1, 5, and 19.

25. Regarding **claim 24**, the further limitation of claim 21, see the preceding argument with respect to claim 9. The combination teaches these features.

26. Regarding **claim 25**, the further limitation of claim 24, see the preceding argument with respect to claim 7. The combination teaches these features.

27. Regarding **claim 26**, the further limitation of claim 25, it is *admitted prior art* that WinAmp provides the functions of importing a playlist and adding, or combining, another playlist.

Response to Arguments

28. Applicant's arguments with respect to claims 1-5, 7-15, and 17-26 have been considered but are moot in view of the new ground(s) of rejection.

29. Regarding claims 1, 5, 19, and 26, the applicant has not properly traversed an Official Notice presented by the Office, and therefore it is an admission of prior art (see MPEP 2144.03(c)).

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Van Ryzin, USPN 6,393,430;

Katinsky et al., USPN 6,452,609; and

Phillips et al., US PGPub 2002/0045960.

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 571-272-7528. The examiner can normally be reached on Monday to Friday, 9am to 5:30pm.

Art Unit: 2615

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571)272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DRS



SINH TRAN
SUPERVISORY PATENT EXAMINER